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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,389	10/02/2001	Donald J. Merkley	129843.1022	9683
60148	7590	06/19/2006	EXAMINER	
GARDERE / JAMES HARDIE GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201			HALPERN, MARK	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/970,389	Applicant(s) MERKLEY ET AL.	
	Examiner Mark Halpern	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- 1) Acknowledgement is made of Amendment received 5/3/2006.

Claims 25 and 33 are amended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2) Claims 25-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAJI (6,030,447) in view of the ADMITTED PRIOR ART (APA)(Specification paragraph [0031] and Table 1) with or without WINGERSON (6,419,788). NAJI teaches a composite building material comprising cellulose fibers, which reinforce the product (col. 2, lines 7-19, and an aggregate (siliceous material, Abstract), a density modifier (col. 2, line 21) and one or more additives (col. 2, lines 20-31). The APA teaches that conventional pulping and washing at temperatures (55-60 °C) results in cellulose fibers, e.g. the cellulose fibers of NAJI, having a COD content of 5 kg/ton. In view that the claim does not specifically recite an elevated temperature in degrees centigrade, the temperature of APA is considered an elevated temperature. The claimed "less than 5 kg/ton" and in claims 44-48 "greater than 5 kg/ton" reads on 5 kg/ton of APA. The "less than 5.0 kg/ton", does not define over the washing of the APA or the product of

NAJI. Also, WINGERSON teaches producing substantially pure cellulose (col. 3, line 56) by first treating cellulosic material with steam and then washing with alkaline hot wash water containing dissolved oxygen at elevated temperatures, e.g. 180 to 240 °C to remove decompose, mobilize and remove lignin, extractives and residual hemicellulose, e.g. the COD's. It would have been obvious to the artisan to further remove the COD's of NAJI and/or the APA using the elevated washing temperatures of WINGERSON. Such a washing would lower the COD's of NAJI to less than 5 kg/ton. It is noted that the instant process can also use oxidized wash liquor, e.g. the same wash water used by WINGERSON, see instant specification page 3, [0009].

Response to Amendment

3) Applicants' arguments filed 5/3/2006, have been fully considered but they are not persuasive.

Applicants allege that the cited prior art, NAJI, does not disclose a composite formulation containing fibers.

NAJI teaches a composite building material comprising cellulose fibers, which reinforce the product (col. 2, lines 7-19, and an aggregate (siliceous material, Abstract), a density modifier (col. 2, line 21) and one or more additives (col. 2, lines 20-31).

Applicants allege that the cited prior art, NAJI, does not disclose a portion of fibers pretreated at an elevated temperature washing.

This feature is disclosed by the APA. The APA teaches that conventional

pulping and washing at temperatures (55-60 °C) results in cellulose fibers, e.g. the cellulose fibers of NAJI, having a COD content of 5 kg/ton. In view that the claim does not specifically recite an elevated temperature in degrees centigrade, the temperature of APA is considered an elevated temperature. Also WINGERSON discloses washing at elevated temperature.

Applicants allege that the cited prior art, WINGERSON, is not properly combinable with NAJI, because the reference became available to the public July 16, 2002, and the present filing itself has a priority date of 10/17/200.

WINGERSON is available as prior art under 35 USC 102(e), therefore it is combinable under 35 USC 103(a) with NAJI.

Conclusion

4) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 571-272-1190. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Mark Halpern
Primary Examiner
Art Unit 1731